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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,429	08/05/1999	FUMIHIKO YAMAGUCHI	0950-0110P	5516

2292 7590 02/10/2003

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

178

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,429

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) 3,6-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 24, 2002 has been entered.

Response to Amendment

2. Amendment D, submitted as Paper No. 17 on December 24, 2002, has been entered. Claims 1 and 10 have been amended and claim 14 has been added. Therefore, the pending claims are 1 – 3 and 5 – 14. Claims 3, 6 – 9 and 11 are withdrawn from consideration as being drawn to nonelected inventions.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sargent et al. (5,316,850).

Sarsent et al. discloses a method for stainproofing fibers in textiles such as carpets (abstract). The stainresistant composition includes a reactive compound which reacts with the carpet fiber (column 2, lines 53 – 64) and a stain resist treatment composition which reacts with

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the reactive compound (column 2, line 65 – column 3, line 4). The fiber can then be treated with a fluorocarbon composition (column 3, lines 5 – 7). The reactive compound is made from a material which is well suited to nucleophilic displacement such as triazine rings (column 5, lines 47 – 56 and column 7, lines 49 – 61). Further, catalysts including formic acid and acetic acid, which are types of organic carboxylic acids, are used to adjust the pH (column 8, line 65 – column 9, line 5). Thus, claims 1 and 10 are rejected.

Claim Rejections - 35 USC § 102/103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 3 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sargent et al.

The features of Sargent et al. have been set forth above. Although Sargent et al. does not explicitly teach the limitations stain-proof ratio, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. triazine rings and fluorocarbons) and in the similar production steps (i.e. bonding the triazine rings to the fibers) used to produce the stain resistant carpet. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Sargent et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Thus, claims 3 and 13 are rejected.

Claim Rejections - 35 USC § 103

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7. Claims 1, 2, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A or Kato et al. (5,349,003) in view of Pacifici et al.

Claims 1, 2, and 13 are rejected for the reasons of record. Amendment D changed the scope of claim 10 so it is now also rejected for the reasons set forth in the previous Office Actions.

8. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A in view of Pacifici et al. as applied to claim 1 above, and further in view of Kubo et al. (5,883,175) for the reasons of record.

9. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable Sargent et al. in view of Kubo et al.

The features of Sargent et al. have been set forth above. While Sargent et al. discloses that known fluorocarbons can be used in this invention, Sargent et al. fails to specifically teach using the fluorocarbons recited in claim 5. Kubo et al. is drawn to fluoroalkyl stainproofing compositions. Kubo et al. teaches that the fluoroalkyl containing component can be a polyfluoroalkyl group-containing (meth)acrylate or a polyfluoroalkyl group-containing maleate (column 2, lines 28 – 55). Thus, it would be obvious to one having ordinary skill in the art to substitute a polyfluoroalkyl group-containing maleate for the polyfluoroalkyl group-containing (meth)acrylate in the Sargent et al. composition to produce a less toxic fluorocarbon chemical with an equivalent fluoroalkyl group-containing compound, thereby improving the safety of those who come in contact with the chemicals and saving money on chemical disposal. Therefore, claim 5 is rejected.

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10. Claims 1, 2, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. (5,143,991) in view of Kato et al. and Pacifici et al.

Claims 1, 2, 10, and 13 are rejected for the reasons of record. Newly added claim 14, is similar to the old claim 10 and is rejected for the reasons set forth in the previous Office Actions.

11. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A or Kato et al. (5,349,003) in view of Pacifici et al. as applied to claim 1 above for the reasons of record.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. in view of Kato et al. and Pacifici et al. as applied to claim 1 above for the reasons of record.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sargent et al.

The features of Sargent et al. have been set forth above. Sargent et al. fails to teach the carpet color. However, it is well known to dye carpets various colors so that the carpets will be aesthetically pleasing to numerous people and so that the carpets can be matched with already existing décor. Thus, it would have been obvious for one having ordinary skill in the art to choose blue as the color to dye the above carpets since blue is a primary color which can be matched with various other colors and blue is a popular color which is liked by a wide variety of people. Further, it would have been obvious to one having ordinary skill in the art to dye the carpet the recited blue color, since it has been held to be within the general skill of a worker in the art to select a known material (i.e., color) on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Thus, claim 12 is rejected.

Response to Arguments

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13. Applicant's arguments filed December 24, 2002 have been fully considered but they are not persuasive. The Applicant argues that the "consisting essentially of language" excludes the excess components taught by the prior art (Amendment D, pages 10 – 12). The Examiner agrees that the "consisting essentially of" language excludes components that *materially* affect the *basic* and *novel* characteristics of the composition. However if an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). The Applicant has provided no clear evidence that demonstrates that the additional components taught by the prior art would indeed materially affect the basic and novel characteristics of the invention. In other words how does the urea component taught by JP '175 hinder the stain resistance of the triazine and fluorochemical in the composition. Does the composition with the urea component has a decreased stain resistance? Additionally, the other rejections are maintained until the Applicant provides evidence showing that the additional components *materially* affect the *basic* and *novel* characteristics of the claimed composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
February 3, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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